

Appl. No. 10/748,645
Arndt. dated April 8, 2005
Reply to Office Action of January 10, 2005

REMARKS

Claims 1-36 are pending in the instant application. In the Office Action mailed January 10, 2005, the Examiner rejects claims 1-34. Claims 16, 33, and 34 are canceled. Claims 35 and 36 are added with support in the original application at page 6, lines 4-8.

By virtue of the amendments to the claims presented above, independent claims 1, 26, 27, and 30 are amended. Based on the amendments and remarks made herein, Applicants respectfully request that the rejections be withdrawn and that the application be passed to allowance.

1. Remarks on Paragraph 3 of the Office Action mailed on January 10, 2005: Rejection of Claims 1-3, 6, 8, 12, 14-17, 19-20, 22, and 24-26 Under 35 U.S.C. §102(e)

In the Office Action mailed January 10, 2005, the Examiner rejects claims 1-3, 6, 8, 12, 14-17, 19-20, 22, and 24-26 as being unpatentable under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. 2003/0044569 to Kacher (hereinafter "the Kacher application").

With respect to claims 1 and 26, the Examiner believes the Kacher application discloses each of the elements presented by the Applicant in the original application.

Claim 1 as amended is directed to animal shedding control device including a first layer including a first material, wherein the first layer has a first layer perimetric edge, and wherein the first material is hook material having hooks adapted to capture detritus; a second layer including a second material, wherein the second layer has a second layer perimetric edge, and wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed, wherein the bag-like space includes an open end; and a sealing mechanism positioned adjacent the open end. Contrary to the Examiner's assertions with respect to claims 16, 17, and 19, the Kacher application does not disclose a sealing mechanism. There is some discussion in the Kacher application of attaching a cleaning sheet to itself (see paragraph 0158) or of attaching a cleaning sheet to a mop head (see paragraph 0161), but there is no disclosure of an animal shedding control device including a sealing mechanism.

Claim 26 is directed to a shedding control device including a bag-like body including an outer surface including micro-hook material, an interior space, wherein the body is adapted to be turned inside-out to create a second interior space; and a sealing mechanism. Contrary to the Examiner's assertions with respect to claims 16, 17, and 19, the Kacher application does not disclose a sealing mechanism. There is some discussion in the Kacher application of attaching a cleaning sheet to

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itself (see paragraph 0158) or of attaching a cleaning sheet to a mop head (see paragraph 0161), but there is no disclosure of an animal shedding control device including a sealing mechanism.

With respect to claim 12, the Examiner believes the Kacher application discloses a thumb space. Claim 12 is directed to the device of claim 1, further comprising a thumb space. The Kacher application discloses only an internal cavity (see paragraph 0159) and no thumb space; no thumb space is illustrated in the figures in the Kacher application. In addition, claim 12 is a dependent claim that depends from an allowable independent claim, and is thus allowable itself for the reasons stated above with respect to claim 1.

Claims 2, 3, 6, 8, 14, 15, 17, 19, 20, 22, 24, and 25 are dependent claims that depend from an allowable independent claim, and are thus allowable themselves for the reasons stated above with respect to claim 1.

In view of the remarks set forth in this section, Applicants respectfully submit that claims 1-3, 6, 8, 12, 14, 15, 17, 19, 20, 22, and 24-26 are in condition for allowance and respectfully request favorable consideration and the timely allowance of those claims.

2. Remarks on Paragraph 4 of the Office Action mailed on January 10, 2005: Rejection of Claims 4, 5, 7, 9-11, 13, 18, 21, 23, and 26-34 as Obvious

In the Office Action mailed January 10, 2005, the Examiner rejects as being unpatentable under 35 U.S.C. §103(a) over the Kacher application claims 4 and 27 in view of U.S. Patent No. 5,524,575 to Lennon ("the Lennon patent"), claims 5, 21, and 34 in view of U.S. Patent No. 6,604,742 to El Sabbagh ("the El Sabbagh patent"), claim 7 in view of U.S. Patent No. 5,724,911 to McAlister ("the McAlister patent"), claims 9, 11, and 33 in view of U.S. Patent No. 5,682,837 to Courtney et al. ("the Courtney patent"), claim 10 in view of U.S. Patent No. 5,494,720 to Smith et al. ("the Smith patent"), claim 13 in view of WO Patent No. 03/045135 ("the WO patent"), claim 18 in view of U.S. Patent No. 6,203,080 to Surplus ("the Surplus patent"), claim 23 in view of U.S. Patent No. 5,072,694 to Haynes et al. ("the Haynes patent"), claim 30 in view of the rejection for claim 23, claim 26 in view of U.S. Patent Application Publication No. 2003/0041813 to Demeur et al. ("the Demeur application"), claims 28 and 29 in view of the Lennon patent and further in view of the Demeur application, claims 31 and 32 in view of the Haynes patent and further in view of the Demeur application, Applicants respectfully traverse the rejections.

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Claim 27 is directed to a method for controlling animal shedding, the method including donning a mitt having a first layer including a first material, wherein the first layer has a first layer perimetric edge, and wherein the first material is hook material having hooks adapted to capture detritus, a second layer including a second material, wherein the second layer has a second layer perimetric edge, and wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed, wherein the bag-like space includes an open end, and a sealing mechanism positioned adjacent the open end. The method further includes petting an animal having detritus such that detritus is captured in the hooks; and disposing of the mitt. As stated above, and contrary to the Examiner's assertions with respect to claims 16, 17, and 19, the Kacher application does not disclose a sealing mechanism. There is some discussion in the Kacher application of attaching a cleaning sheet to itself (see paragraph 0158) or of attaching a cleaning sheet to a mop head (see paragraph 0161), but there is no disclosure of an animal shedding control device including a sealing mechanism. The addition of the Lennon patent does not correct this deficiency. The Lennon patent also does not teach or disclose an animal shedding control device including a sealing mechanism.

With respect to claim 4, the Examiner believes that the Lennon patent discloses a second material that is an elastomeric material (col. 3, lines 21-30 disclose "latex or other soft rubber"). Claim 4 is directed to the device of claim 1, wherein the second material is an elastomeric material. The Examiner has already asserted with respect to independent claim 1 that the Kacher application discloses a first material associated with the first layer (as both are defined by the Examiner) that is a hook material, thus making the equivalent layer 42 of the Lennon patent the first material. In the instant application, the second material is associated with the second layer (which defines a bag-like space with the first layer). The material of the similar structure in the Lennon patent is not disclosed by the Lennon patent. The Lennon patent does not disclose a second material that is an elastomeric material.

With respect to claim 5, the Examiner believes the El Sabbagh patent discloses micro-hook material as a second material. Claim 5 is directed to the device of claim 1, wherein the second material is micro-hook material. Contrary to the Examiner's assertion, the El Sabbagh patent does not disclose the use of a micro-hook material as a second material. At col. 3, lines 47-59, the El Sabbagh patent describes a simple version of its glove as being "covered with hook material." The simple mention of hook material does not disclose an embodiment in which the second material is a micro-hook material, and the use of the term hook material, or even the trademark "Velcro," does not disclose micro-hook material as defined by the Applicants at page 3 of the instant application.

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With respect to claim 21, the Examiner believes the El Sabbagh patent discloses first and second materials as part of the same material, and one of a first and second layer folded over the other. Claim 21 is directed to device of claim 1, wherein the first and second materials are one piece of the same material, wherein the first layer and the second layer are two portions of the piece, and wherein one of the first and second layer is folded over the other of the first and second layer. First, and contrary to the Examiner's assertion, the El Sabbagh patent does not disclose first and second materials as one piece of the same material. At col. 3, lines 47-59, the El Sabbagh patent describes a simple version of its glove as being "covered with hook material." The El Sabbagh patent does not disclose that various portions of its glove are one piece of the same material. Similarly, the El Sabbagh patent does not disclose that the first and second layers are two portions of that piece of material. The Examiner first identifies elements 36 and 42 as the first and second layers and as two portions of the same piece. Simply put, that is a conclusory statement without basis in the El Sabbagh patent because the El Sabbagh patent only labels 36 and 42 as top and bottom portions with no real disclosure as to their construction. The Examiner then reassigns elements 40 and one of the 44s as the first and second layers. The second layer 44 as described by the Examiner is a separate structure from the second layer 42 as described by the Examiner.

With respect to claim 7, the Examiner believes the McAlister patent discloses a pet bed enclosure. Claim 7 is directed to the device of claim 1, wherein the device is a pet bed enclosure. There is no teaching or suggestion to combine these references because the McAlister patent teaches away from the combination of a pet bed and a cover. The McAlister patent states that "the lack of a cover over the raw polyester is important" (col. 2, lines 15-16) and that "the invention relates to an uncovered fibrous bed." (col. 1, line 7) In addition, the one motivation for such a combination presented by the Examiner, to "allow for the device to be self-operating," is already accomplished by the McAlister patent alone. See col. 2, lines 24-29: "[Raw, unwoven polyester] has two properties that make it ideal for the present use as a bed for a pet: It is naturally electrostatic . . . cat hairs and dander tend to cling to this material rather than being spread over the house."

With respect to claims 9 and 11, the Examiner believes the Courtney patent discloses a first layer coupled to a second layer by adhesive or sewing. Claim 9 is directed to the device of claim 1, wherein the first layer is coupled to the second layer using adhesive. Claim 11 is directed to device of claim 1, wherein the first layer is coupled to the second layer by sewing. The Courtney patent actually discloses options for attaching a pad 12 to a glove 20. These two elements cannot be made equivalent to the first and second layers defined by the Applicant because the first and

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second layers define a bag-like space. The pad and glove in the Courtney patent do not define a bag-like space.

With respect to claim 23, the Examiner believes the Haynes patent discloses a material 36 with a space sized to substantially enclose a pet bed 40. Claim 23 is directed to the device of claim 1, wherein the space is sized to enclose a pet bed. With respect to claim 30, the Examiner believes the basis for rejection of claim 23 applies to claim 30 as well. Claim 30 is directed to a method for controlling animal shedding, the method including enclosing an animal bed with a device having a first layer including a first material, wherein the first layer has a first layer perimetric edge, and wherein the first material is hook material having hooks adapted to capture detritus, a second layer including a second material, wherein the second layer has a second layer perimetric edge, and wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed, wherein the bag-like space includes an open end, and a sealing mechanism positioned adjacent the open end. The method also includes allowing an animal to use the bed such that detritus is captured in the hooks; removing the device from the bed; and disposing of the device. First, for the reasons presented above with respect to claim 1, for example, the Kacher application does not disclose a device as defined in claim 1. Similarly, the Kacher application does not disclose a device as claimed in claims 23 or 30. Second, the Haynes patent does not correct these deficiencies. The Haynes patent discloses a piece of material 36 positioned above a pet bed 40. Referring in particular to Figs. 2 and 3 in the Haynes patent, the material 36 is positioned above a pet bed 40 and encloses no part of such pet bed. Even if the material in the Haynes patent is seen as overlying a portion of the pet bed of the Haynes patent, the material does not "enclose" a pet bed.

With respect to claim 26, and to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The Examiner bears the initial burden of establishing the *prima facie* case. See In re Plasecki, 223 U.S.P.Q. 785,787, 745 F.2d 1468, 1471 (Fed. Cir. 1984).

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1. The Examiner has not met the burden of establishing prima facie obviousness by failing to identify the motivation in the Kacher application for modifying its teachings with the teachings of the Demeur application.

Claim 26 is directed to shedding control device including a bag-like body including an outer surface including micro-hook material; an interior space, wherein the body is adapted to be turned inside-out to create a second interior space; and a sealing mechanism. Neither of the two cited references (the Kacher application and the Demeur application) disclose the claimed devices. The Examiner improperly "picked and chose" the components from the two references using the claimed invention as a template in order to form the rejection.

In the Office Action mailed January 10, 2005, the Examiner states that "it would have been obvious to one of ordinary skill in the art to take the device of Kacher et al. and add the body capable of being turned inside out of Demeur et al., so as to allow the user of the device to stay clean during use of the device." In this Office Action, the Examiner attempts to provide an explanation of the motivation for combining the references. The Examiner's explanation is insufficient. The sole motivation asserted by the Examiner, one of allowing "the user of the device to stay clean during use of the device," does not appear in the Kacher application. The Kacher application already reveals the ease of disposal of a mitt (see paragraph 0159), thereby not requiring further elements to keep a user clean. There is, therefore, no motivation within the patents to apply the teachings of one to the other. The Examiner does not adequately state why one of ordinary skill would read the Kacher application and then look to the Demeur application to convert the device to the another device to arrive at the device of claim 26.

Further, the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. In re Napier, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). The Examiner has pointed to no disclosure within either application that one of skill in the art would look to for such motivation or teaching. Again, the Examiner has not explained why one would look at device identified in the Kacher application and be motivated to change them by applying the teaching of the Demeur application. The Examiner has failed to identify how the cited reference suggests the desirability of modifying the device of the Kacher application to include components from the Demeur application. In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."). Unless the Examiner provides an adequate explanation of the motivation to

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combine the cited references, it appears that she has used the claimed invention as a "template" to pick and choose the components of claim 26 from the prior art. Id. quoting In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)¹. For at least these reasons, Applicants assert that a *prima facie* case of obviousness has not been made and that claim 26 is patentable over the references.

2. The Examiner has not met the burden of establishing *prima facie* obviousness by failing to meet the burden of establishing that the prior art reference (or references when combined) teach or suggest all the claim limitations. And by failing to meet the burden of establishing that there would be a reasonable expectation of success associated with modifying the device of the Kacher application include components from the Demeur application.

As discussed above with respect to claim 26, the Kacher application does not teach or suggest all of the claim limitations. Contrary to the Examiner's assertions with respect to claims 16, 17, and 19, the Kacher application does not disclose a sealing mechanism. There is some discussion in the Kacher application of attaching a cleaning sheet to itself (see paragraph 0158) or of attaching a cleaning sheet to a mop head (see paragraph 0161), but there is no disclosure of an animal shedding control device including a sealing mechanism. The Demeur application does not correct these deficiencies. In addition to indicating why the cited references provide the requisite motivation and suggestion to be combined, the Examiner should also have indicated why the references provide the required expectation of succeeding in the endeavor. The Examiner has not shown that the references would have suggested to one of ordinary skill in the art that various components from the references should be combined and would have a reasonable likelihood of success. Both the suggestion and the expectation of success must be found in the cited references, not in Appellants' disclosure. In re Dow Chemical, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Claims 10, 13, 18, 28, 29, 31, and 32 are dependent claims that depend from a allowable independent claims, and are thus allowable themselves for the reasons stated above with respect to claims 1, 27, and 30.

¹ "Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"

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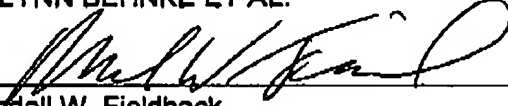
In view of the remarks set forth in this section, Applicants respectfully submit that claims 4, 5, 7, 9-11, 13, 18, 21, 23, and 26-32 are in condition for allowance and respectfully request favorable consideration and the timely allowance of those claims.

In conclusion, and in view of the remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable consideration and the timely allowance of pending claims 1-15, 17-32, 35, and 36. If any additional information is required, the Examiner is invited to contact the undersigned at (920) 721-8863.

The Commissioner is hereby authorized to charge any prosecutorial fees (or credit any overpayment) associated with this communication to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I, Mary L. Roberts, hereby certify that on April 8, 2005 this document is sent by facsimile transmission to the Commissioner for Patents via facsimile number (703) 872-9306.

By: 
Mary L. Roberts